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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,712	06/26/2003	Akihiko Suyama	393032038600	6937
7590	08/29/2006			EXAMINER PHAM, VAN T
David L. Fehrman Morrison & Foerster LLP 35th Floor 555 W. 5th Street Los Angeles, CA 90013			ART UNIT 2627	PAPER NUMBER
				DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/608,712	SUYAMA, AKIHIKO	
	<b>Examiner</b> VAN T. PHAM	<b>Art Unit</b> 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 June 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.  
 4a) Of the above claim(s) 1,10,19 and 22 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 2-9,11-18,20,21,23 and 24 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 26 June 2003 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

***Election/Restrictions***

1. Applicant's election with traverse of Species B (Figs. 5-10) in the reply filed on 6/12/2006 is acknowledged. The traversal is on the ground(s) that Figs. 11 and 13 are not mutually exclusive given that operations illustrated in Figs. 7 and 8 could be used to form a plurality of visual images or used for duplicating. This is found persuasive. Therefore, claims 2-9, 11-18, 20-21, and 23-24 are pending.

***Drawings***

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***101 Rejections***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 11-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 11-18 are drawn to a "program" *per se* as recited in the preamble and as such is non-statutory subject matter. See MPEP § 2106.IV.B.1.a.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 2-3, 5-6, 11-12, 14-15, 20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Onodera et al. (US 2001/0040867).

Regarding claim 2, Ondera discloses a method of forming a visual image having a specified shape on a surface of an optical disk by using an optical writing process of irradiating a laser beam onto the surface of the optical disk to form pits (see [0010]), the optical disk being capable of recording information on the surface thereof by the optical writing process (see [0010]-[0011]), the method comprising the steps of: acquiring image formation information associated to a visual image to be formed (see Figs. 7-9, 12-13); forming the visual image on the surface of the optical disk based on the acquired image formation information by using the optical writing process (see Figs. 3-6, 12-13); and recording the image formation information together with the formed visual image on the surface of the same optical disk by using the optical writing process (see Fig. 4-7 and 10-11, [0163]-[0169]).

Regarding claim 3, see Figs. 6 (step S226), 10 (step s330), 11 (step S436), discloses the method to claim 2, further comprising the step of placing the optical disk in a recording end state after the image formation information is recorded so that the optical disk is made unable to additionally record information any more.

Regarding claim 5, see Figs. 3-4, discloses the method according to claim 2, wherein the step of recording records the image formation information containing start address information

specifying a position of the surface of the optical disk to start the optical writing process for forming the visual image, stop address information specifying another position to stop the optical writing process for forming the visual image, and pattern information specifying a pattern of irradiating the laser beam during the optical writing process for forming the visual image (see [0048]-[0051], [0060], [0080], [0089], ).

Regarding claim 6, see Figs. 3 (display unit 4), 8-9, 13, discloses the method according to claim 2, wherein the step of recording records the image formation information containing image data which represents the visual image and which is recorded in a format readily readable from the optical disk for reproduction of the visual image on a display.

Regarding claims 11, 20 and 23 see rejection above of claim 2.

Regarding claim 12, see rejection above of claim 3.

Regarding claim 14, see rejection above of claim 5.

Regarding claim 15, see rejection above of claim 6.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 7-8, 13, 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Onodera et al. (US 2001/0040867) further in view of Takase Tsunemitsu (JP 2003051118).

Regarding claim 4, Onodera discloses the method according to claim 2, further comprising the step of placing the optical disk in a recording end state on the surface of the optical disk so that the optical disk is made unable to additionally record information except for the reserved area, wherein the step of recording records the image formation information in the reserved area after the optical disk is placed in the recording end state.

Takase discloses a the step of placing the optical disk in a recording end state while leaving a reserved area on the surface of the optical disk so that the optical disk is made unable to additionally record information except for the reserved area, wherein the step of recording records the image formation information in the reserved area after the optical disk is placed in the recording end state (see [0002] and [0180]-[0190] wherein Takase discloses a disk has a multi-session).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide recording records the image formation information in the reserved area in Onodera, as suggested by Takase, the motivation being in order to postscript of new data is possible after recording data (see Takase [0002]).

Regarding claims 7 and 8, see Figs. 8-9, 13, d Onodera discloses the method according to claim 2. However, Onodera does not disclose the step of recording is capable of consecutively recording a plurality of image formation information corresponding to a plurality of visual images, such that each image formation information contains address information which

specifies a start address of next image formation information or specifies a reserved area for next image formation information or the step of recording is capable of recording a plurality of image formation information corresponding to a plurality of visual images, so that the step of forming can successively form the plurality of the visual images on the surface of the optical disk without overlapping with each other based on the plurality of the recorded image formation information.

Takase discloses a step of recording is capable of consecutively recording a plurality of image formation information corresponding to a plurality of visual images, such that each image formation information contains address information which specifies a start address of next image formation information and specifies a reserved area for next image formation information or the step of recording is capable of recording a plurality of image formation information corresponding to a plurality of visual images, so that the step of forming can successively form the plurality of the visual images on the surface of the optical disk without overlapping with each other based on the plurality of the recorded image formation information (see [0180]-[196]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a plurality of image formation information corresponding to a plurality of visual images in Onodera, as suggested by Takase, the motivation being in order to postscript of new data is possible after recording data (see Takase [0002]).

Regarding claim 13, see rejection above of claim 4.

Regarding claims 16-17, see rejection above of claim 7-8, respectively.

- 9, 18, 21, 24 are*  
9. Claims rejected under 35 U.S.C. 103(a) as being unpatentable over Onodera et al. (US 2001/0040867) further in view of Yamamoto Kazutaka (JP 2002367173).

Regarding claim 9, the method of claim 2. However, Onodera does not disclose a step of copying the image formation information recorded in the origin optical disk to the duplicate optical disk by using the optical writing process; and reproducing the visual image on the surface of the duplicate optical disk by using the optical writing process based on the copied image formation information.

Yamamoto discloses a step of copying the image formation information recorded in the origin optical disk to the duplicate optical disk by using the optical writing process; and reproducing the visual image on the surface of the duplicate optical disk by using the optical writing process based on the copied image formation information (see [0029]-[0030]).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide a step of copying the image formation information recorded in the origin optical disk to the duplicate optical disk by using the optical writing process in Onodera, as suggested by Yamamoto, the motivation being in order to copying images.

Regarding claims 18, 21, 24, see rejection above of claim 9.

***Claim Cited References***

**10.** The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references relate to an optical disk and a reproduction method reproduction apparatus, and recording apparatus for the same and information reproducing method judging a multivalued level of a present call by referring to judged multivalued levels of a preceding cell and a ensuing cell.

**11.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to VAN T. PHAM whose telephone number is 571-272-7590. The examiner can normally be reached on Monday-Thursday from 9:00am – 6:00pm.

Art Unit: 2627

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571-272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VP



WAYNE YOUNG  
SUPERVISORY PATENT EXAMINER